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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/234.145 04/28/94 KUCHERLAPATI

R 43640002.24

ZISKA, S

EXAMINER

18N2/0921

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ART UNIT PAPER NUMBER

1804

DATE MAILED:
09/21/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 9 month(s), 10 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-12 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-12 are subject to restriction or election requirement.
7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claim 1, drawn to a method for producing a xenogeneic immunoglobulin comprising immunizing a host with an immunogen and isolating xenogeneic immunoglobulins produced by the host, classified in Class 424, subclass 184.1, for example.

Group II. Claim 2, drawn to an immortalized non-human cell line genetically modified so as to lack the ability to produce endogenous immunoglobulin, classified in Class 435, subclass 240.2, for example.

Group III. Claim 3, drawn to a method of producing a xenogeneic immunoglobulin, classified in Class 435, subclass 69.6, for example.

Group IV. Claims 4-7 and 10-12, drawn to a xenogeneic immunoglobulin, classified in Class 530, subclass 387.1 and 388.15, for example.

Group V. Claims 8 and 9, drawn to a method of producing a modified non-human animal comprising xenogeneic DNA stably integrated into the genome and an ES cell, classified in Class 435, subclass 172.3, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions (I and III) and Invention IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the product as claimed can be made by either of the materially different process of Invention I (in vivo) or III (hybridoma).

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Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product as claimed, the immortalized non-human cell line can be used in a materially different process such as propagation of the cell line, for example. Invention V, drawn to a method for producing a modified non-human animal, is an independent and distinct invention since the method of Invention V does not require the materials or the methods of any other Invention.

Because these inventions are distinct for the reasons given above and acquired a separate status in the art as shown by their different classification, recognized divergent subject matter and separate search requirements, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO FAX center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the

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Official Gazette, 1096 OG (30 November 15, 1989). The CM1 Fax Center number is (703) 308-4227.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Suzanne Ziska, Ph.D., whose telephone number is (703) 308-1217. In the event the examiner is not available, the examiner's supervisor, Ms. Jacqueline Stone, may be contacted at phone number (703) 308-3153.


SUZANNE E. ZISKA
PRIMARY EXAMINER
GROUP 1800